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SHAW PITTMAN L.L.P..  
BRETT C. MARTIN  
1650 TYSONS BOULEVARD  
IP GROUP  
MCLEAN, VA 22102

EXAMINER

HECK, MICHAEL C

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 05/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/577,658

Applicant(s)

OWEN ET AL.

Examiner

Michael Heck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-6,9-11,23,25 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-6,9-11,23,25 and 27-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01 March 2004 has been entered.

2. The following is the First Office Action in response to the request for continued examination filed 01 March 2004. Applicant's amendment of 01 March 2004 amended claims 27, 28 and 30, canceled claims 8 and 26, and added claims 31 and 32. Currently claims 2-6, 9-11, 23, 25, and 27-32 are pending in this application and have been examined on the merits as discussed below.

### ***Response to Amendment***

3. The objection to the drawings in the Final Office Action of 29 August 2003 is withdrawn in response to the applicant's new drawings with the exception of previously noted Figure 6 discrepancy of missing the detailed information that filled in the blanks.

4. The objection to the specification in the Final Office Action of 29 August 2003 is withdrawn in response to the applicant's amendment to the specification.

5. The 35 U.S.C. 112 second paragraph rejection in the Final Office Action of 29 August 2003 for claims 27 and 28 are withdrawn in response to the applicant's amendment to the claims.

***Response to Arguments***

6. Applicant's arguments in regard to claims 27 and 30, filed 01 March 2004 have been fully considered but they are not persuasive. Applicant argues that Kraft (Kraft, K., There's a Goldmine in Collections! Using Contact Management Software to Manage Your Collection Effort, Newspaper Financial Executives Quarterly, Reston, Vol. 3 Issue 4, Third Quarter 1997, pages 28-29 [PROQUEST]) teaches utilizing the customer contact database from the collections side to aide the sales force in having their own contact database, but does not teach the synergistic result of having a contact management system that also makes billings information available to the sales representatives. Specifically, the applicant amended claims 27 and 30 to recite that the system and method provide billing information associated with the particular entity or customer in the database for review by sales representatives and argues that the billings information is not disclosed as being reviewable within the sales contact database. Applicant amended claims 27 and 30 by adding the features of canceled claims 8 and 26 with the features of claims 27 and 30, respectively, however the rejection of the features of claims 8 and 26 are still applicable to the applicant's invention. In response, the claims as written discloses a database in communication with the menu-driven interface portion, the database comprising memory and information in the memory, including contact information related to a customer and billing information associated with the customer for review by the sales representatives. Kraft teaches that many of the concepts in sales force automation, and contact management, also applied to collections. The first step was to create a file in the advertising billing system that was downloaded into the Goldmine database. The Goldmine customer contact screen was modified to display the information and an interface program was written to periodically download and

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update the information. The fields identified as being needed for the collection effort included customer name, account number, address, phone number, contact person, sales rep number, balance due, balance past due, the various aging buckets, credit limit, credit code, last sales amount, last sales date, last payment amount, and last payment date. The Goldmine customer contact screen was modified to display this information in a very user-friendly environment (Page 28, Col. 1 and 2). Kraft clearly linked billing information to the customer contact information and made it reviewable within the sales contact database. The synergistic result of having a contact management system that also makes billings information available to the sales representatives was not claimed.

7. Applicant's arguments in regard to claims 23 and 29, filed 01 March 2004 have been fully considered but they are not persuasive. Applicant argues that Zarowitz et al. (Zarowitz et al., Using Technology to Maximize Marketing Opportunity: PR Management for the 21<sup>st</sup> Century, Public Relations Tactics, New York, Vol. 5, Issue 11, November 1998, page 18 [PROQUEST]) discusses tracking performance of employees and progress of a project, however, there is no explanation of what "client placement" is or whether this is information regarding the quality of the customer contact as recited in claim 29 or if it relates to project progress. In response, claim 29 recites receiving customer contact information related to a customer contact from the employee, including information related to the quality of the customer contact, and reviewing the information of the quality of the customer contacts associated with the employee to determine performance of the employee. Claim 29 was rejected by Zarowitz et al. in view of Metzler (Metzler, J., Contact Managers Build a Database to Hike Sales, Accounting Today, Copyright Faulkner and Gray Inc., New York, Vol. 9, Issue 18, 9 October 1995, starting p. 22

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[PROQUEST]). Metzler teaches a practicing CPA (the examiner interprets a CPA to be an employee) uses user definable fields where the type of contact has been designated. Prospects are rated such as hot, cool or suspect contacts (Para 10-14). Specifically, Metzler teaches some of the fields include the type of contact the particular company is – a contact, referral source, influencer, friend, vendor, or existing client. Metzler also teaches the prospects are rated as an A, B, C, or S, with A denoting a hot prospect, C being a cool prospect and S being a suspect. The applicant defined the quality of customer contact can be, for example, the depth of customer contact and whether the contact furthers potential sales or is merely a maintenance contact for which a sales representative should not receive credit. Metzler teaches the details of the quality of the customer contact per the applicant's definition. Metzler also teaches the user can sort all other data by the contact field data or any other field they want (Para 11). Zarowitz et al. teach contact management software allows reports to be set up to track the progress of a project or employee's performance. The manager determines what data measures work efforts and successes. In a contact record client placements can be entered. The reporting function helps track placements, modify marketing strategies, and demonstrate accountability (Para 13). The examiner interprets client placement as used by Zarowitz et al. to be the quality of the customer contact, that is, client placements directly relates to the type of contact of Metzler.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 29** is rejected under 35 U.S.C. 103(a) as being unpatentable over Metzler (Metzler, J., Contact Managers Build a Database to Hike Sales, Accounting Today, Copyright Faulkner and Gray Inc., New York, Vol. 9, Issue 18, 9 October 1995, starting p. 22 [PROQUEST]) in view of Zarowitz et al. (Zarowitz et al., Using Technology to Maximize Marketing Opportunity: PR Management for the 21<sup>st</sup> Century, Public Relations Tactics, New York, Vol. 5, Issue 11, November 1998, page 18 [PROQUEST]). Metzler discloses a system and method for managing customer contacts and related information comprising:

- [**Claim 29**] receiving customer contact information related to a customer contact from the employee, including information related to the quality of the customer contact (Para 10-14, Metzler teaches firms want to get running on contact management software quickly. A practicing CPA uses user definable fields where the type of contact has been designated. Prospects are rated such as hot, cool or suspect contacts. The examiner interprets a CPA to be an employee.);
- storing the customer contact information in a database (Para 5, Metzler teaches contact management software places all clients, non-clients, and contacts into a database);
- associating the employee with the customer contact information received (Para 6, Metzler teaches the practitioner devises a personal contact list);
- producing a report including at least some of the customer contact information associated with the employee (Para 9, Metzler teaches most contact management software involves a user definable relational database with integrated activity management and a very flexible report generator.);

Metzler fails to teach reviewing the information of the quality of the customer contacts associated with the employee to determine performance of the employee. Zarowitz et al. teach contact management software allows reports to be set up to track the progress of a project or employee's performance. The manager determines what data measures work efforts and successes. In a contact record client placements can be entered. The reporting function helps

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track placements, modify marketing strategies, and demonstrate accountability (Para 13). The examiner interprets client placement to be the quality of the customer contact. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include the determination of employee performance of Zarowitz et al. with the teachings of Metzler because Metzler teaches it is old and well know in the contact management art to use contact management software as a firm-wide tool, with partners and other professionals accountable to a marketing director (Para 7). Employee responsibilities determine the boundaries for the employee's evaluations. Contact management software gives the marketing managers tools to measure work efforts and successes, therefore, allowing them to evaluate the employees as related to their sales responsibilities.

10. **Claims 2-6, 9-11, 23, 25, 27-28, and 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Metzler (Metzler, J., Contact Managers Build a Database to Hike Sales, Accounting Today, Copyright Faulkner and Gray Inc., New York, Vol. 9, Issue 18, 9 October 1995, starting p. 22 [PROQUEST]) and Zarowitz et al. (Zarowitz et al., Using Technology to Maximize Marketing Opportunity: PR Management for the 21<sup>st</sup> Century, Public Relations Tactics, New York, Vol. 5, Issue 11, November 1998, page 18 [PROQUEST]) in view of Kraft (Kraft, K., There's a Goldmine in Collections! Using Contact Management Software to Manage Your Collection Effort, Newspaper Financial Executives Quarterly, Reston, Vol. 3 Issue 4, Third Quarter 1997, pages 28-29 [PROQUEST]). Metzler and Zarowitz et al. disclose a system and method for managing customer contacts and related information comprising:

- **[Claim 27]** receiving a first item of contact information from one of a plurality of sales representatives (Zarowitz et al.: Para 15-16, Zarowitz et al. teaches contact management software where the software system can retrieve data from a user's Web



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site where someone visiting the Web site has entered their name, address, and so on, and create a contact record. The data is invaluable to the sales department. The examiner interprets sales department to include sales representatives.);

- storing the first item of contact information in a database and associating the contact information with a particular entity (Metzler: Para 5, Metzler teaches contact management software places all clients, non-clients, and contacts into a database.);
- receiving and storing information in the database regarding quality of one or more contacts with the particular entity (Metzler: Para 10-14, Metzler teaches the user designates the type of contact such as a contact, referral source, influencer, friend, vendor, or existing client. This field enables the user to sort all other data by this or any other field they want. Prospects are also rated such as A, B, C, or S where A denotes a hot prospect, C a cool prospect, and S being a suspect. This helps the company know their top five opportunities, at any time. Other fields include client interest such as sports, politics, or religion and important notes on the client.);
- receiving a second item of contact information from one of a plurality of sales representatives (Zarowitz et al.: Para 5, Zarowitz et al. teaches when follow-up calls, meetings, or other actions are scheduled and completed, one click automatically enters the information into the system's record); and
- the second item of contact information received after the first item of contact information (Zarowitz et al.: Para 5, Zarowitz et al. teaches historical activities about contacts can be retrieved. The examiner interprets historical activities relate to chronological or time sequenced activities which can be received.), and
- the first and second items of contact information made available to the plurality of sales representatives (Zarowitz et al.: Para 7, Zarowitz et al. teaches contact management packages for workgroups that allow teams and people to share information).

Metzler and Zarowitz et al. fail to teach receiving billing information associated with the particular entity in the database for review by sales representatives. Kraft teaches that many of the concepts in sales force automation, and contact management, also applied to collections. The first step was to create a file in the advertising billing system that was downloaded into the Goldmine database. The Goldmine customer contact screen was modified to display the information and an interface program was written to periodically download and update the

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information. The fields identified as being needed for the collection effort included customer name, account number, address, phone number, contact person, sales rep number, balance due, balance past due, the various aging buckets, credit limit, credit code, last sales amount, last sales date, last payment amount, and last payment date. The Goldmine customer contact screen was modified to display this information in a very user-friendly environment (Page 28, Col. 1 and 2). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include the capability to review the billing system in relation to the contact management system of Kraft with the teachings of Metzler and Zarowitz et al. because the teaching of Metzler teaches that it was old and well known in the contact management art to manage the marketing process through the sales process to closing opportunities (Para 3). Marketing cost is an important factor in determining the profitability of the sales effort. Implementing the integrated link between the contact management software and the billing system would help reduce system redundancies, therefore, cost, and improved cash flow by reducing outstanding accounts receivables.

- **[Claim 2]** the first item of contact information is received through a website (Zarowitz et al.: Para 15-16, Zarowitz et al. teaches the contact management system can collect information from the Internet).
- **[Claim 3]** the first item of contact information is received from a first sales representative and the second item of contact information is received from a second sales representative (Zarowitz et al.: Para 7-8, Zarowitz et al. teaches a team that is sharing contact information and history using one database. Each person can see what your file says and what the rest of the team is saying.).
- **[Claim 4]** the first and second items of contact information are sent to a third sales representative (Zarowitz et al.: Para 7-8, Zarowitz et al. teaches a team that is sharing contact information and history using one database. Each person can see what your file says and what the rest of the team is saying.).
- **[Claim 5]** the entity is a business (Zarowitz et al.: Para 4, Zarowitz et al. teaches contact management software retrieves business-related information).

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- [Claim 6] the first item of contact information is associated with a sales representative (Zarowitz et al.: Para 3 and 16, Zarowitz et al. teaches a contact management system that can empower your staff to maximize marketing opportunities and successes. Data gathering could be invaluable to the sales department.).
- [Claim 9] reports are generated, including a follow up list (Zarowitz et al.: Para 2 and 13, Zarowitz et al. teaches the contact management software allows you to set up reports to track the progress of a project and allows you to enter information to include when you scheduled follow-ups).
- [Claim 10] the follow up list is sorted chronologically (Zarowitz et al.: Para 6 and 11, Zarowitz et al. teaches the process can automatically populate the contact records to schedule a follow-up call. Advanced calendar and scheduling components are like a personal secretary in that they will remind the user to make those calls, meetings or deadlines. The examiner interprets scheduling to imply chronological order.).
- [Claim 11] sales representatives are automatically notified of appointed contacts (Kraft: Page 29, Col. 1, Para 1, Kraft teaches using the software features that schedule a reminder to call a customer back and then notifies you when its time to call).
- [Claim 23] sales representatives are automatically notified of appointed contacts (Kraft: Page 29, Col. 1, Para 1, Kraft teaches using the software features that schedule a reminder to call a customer back and then notifies you when its time to call).
- [Claim 25] a field for receiving the quality of a customer contact (Zarowitz et al.: Para 4, Zarowitz et al. teaches contact management software retrieves business-related information. Metzler: Para 12-13, Metzler teaches some of the fields include the type of contact and rates the prospects.).
- [Claim 28] the second item of contact information is characterized as having a second quality related to the particular entity different from the subjective quality (Metzler: Para 12-14, Metzler teaches other fields include client interests such as sports, politics, or religion and important notes on the client).

**Claim 30** substantially recites the same limitations as that of claim 27 with the distinction of the recited method being a system. Hence the same rejection for claim 27 as applied above applies to claim 30.

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11. **Claims 31 and 32** are rejected under 35 U.S.C. 103(a) as being unpatentable over Metzler (Metzler, J., Contact Managers Build a Database to Hike Sales, Accounting Today, Copyright Faulkner and Gray Inc., New York, Vol. 9, Issue 18, 9 October 1995, starting p. 22 [PROQUEST]) in view of Melchione et al. (U.S. Patent 5,930,764). As to claim 31, Metzler discloses a system and method for managing customer contacts and related information comprising storing information into a database (Para 5, Metzler teaches contact management software places all clients, non-clients, and contacts into a database) but fails to teach the information reflects that a particular entity desires not to be contacted in the future. Melchione et al. teach a sales and marketing support system using a central customer information system (CCIS) database with the feature of a promotional suppression facility that provides information on customers and non-customers who do not wish to be contacted by telephone and/or mail (title, col. 9, lines 13-29). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include the promotional suppression capability of Melchione et al. with the teachings of Metzler because Metzler teaches that it is old and well known in the contact management art that clients interests and important notes on the client are maintained (Para 14). Companies that are explicit in communicating how their business operates expect outside sales representatives to conform to their requirements in order to make business transactions easier to execute. As such, sales representative that respect the businesses desires will receive the bulk of the sales since they understand and conform to the requirements, therefore, doing business with a customer the way the customer wants business to be conducted shows a level of respect to the customer that leads to mutual benefit.

**Claim 32** substantially recites the same limitations as that of claim 31 with the distinction of the recited method being a system. Hence the same rejection for claim 31 as applied above applies to claim 32.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Davis (Davis, Contact Management Software that works for you, Accounting Today, January 5-January 25, 1998, p. 25-32 [PROQUEST]) discloses an evaluation of different contact management software to include Goldmine and TeleMagic Professional Accountant's Edition. TeleMagic link to the time and billings software is an excellent example of how a tight integration between time and billing applications and contact management software can benefit firms.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Heck whose telephone number is (703) 305-8215. The examiner can normally be reached Monday thru Friday between the hours of 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq R. Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

**Director of the United States Patent and Trademark Office  
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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, Virginia, and the 7th floor receptionist.

mch  
11 May 2004

  
**TARIQ R. HAFIZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600**